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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/759,394	01/16/2004	Daniel R. Foster	13213-061001	6690
26191	7590	11/01/2005		
FISH & RICHARDSON P.C. PO BOX 1022 MINNEAPOLIS, MN 55440-1022			EXAMINER HOGE, GARY CHAPMAN	
			ART UNIT	PAPER NUMBER
			3611	

DATE MAILED: 11/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/759,394	Applicant(s) FOSTER, DANIEL R.	
	Examiner Gary C. Hoge	Art Unit 3611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 October 2005.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-9, 12, 13 and 17-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9, 12, 13 and 17-25 is/are rejected.
- 7) ☒ Claim(s) 26-28 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 March 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-6, 8, 9, 12 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Faiola et al. (4,840,275).

Faiola discloses a greeting card comprising a front panel **34** and a rear panel **36**, the front panel having a front surface, a plurality of peripheral edges, and an interior surface, and a means **14** for retaining and substantially enclosing an object (the recitation that the object is a gift card is a statement of intended use), the retaining means being attached to the front surface of the front panel (via protrusions **18**) and being positioned forward of the front panel, the retaining means being spaced apart from the peripheral edges of the front panel so that a substantial portion of the front surface of the front panel is viewable, wherein the retaining means includes at least one adjustable portion (the protrusions **18**) connected at a fold line, wherein the retaining means is operable to releasably retain the object in a position forward of the front panel when the greeting card is in the folded condition.

Regarding claims 1 and 9, a “bag” is defined as “a container of flexible material, such as paper, plastic, or leather, that is used for storing items.” In this case, the retaining means is a plastic container, which, if sufficient force is applied, is collapsible.

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Regarding claims 2 and 3, the retaining means resembles a miniature hand-held shopping basket, which, according to the definition given above, could be called a “bag.”

Regarding claim 4, Faiola discloses a retention element **26**.

Regarding claim 12, an “envelope” is defined as “something that envelops; a wrapping.”

The retaining means disclosed by Faiola meets that definition.

Regarding claim 13, the retaining means disclosed by Faiola constitutes a miniature gift box.

3. Claims 1-9, 12 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Eisenbraun (5,377,836).

Eisenbraun discloses a card comprising a front panel **10b** and a rear panel **10c**, the front panel having a front surface, a plurality of peripheral edges, and an interior surface, and a means **12** for retaining and substantially enclosing an object (the recitation that the object is a gift card is a statement of intended use), the retaining means **12** being attached to the front surface of the front panel and being positioned forward of the front panel, the retaining means **12** being spaced apart from the peripheral edges of the front panel so that a substantial portion of the front surface of the front panel is viewable, wherein the retaining means includes at least one adjustable portion **12e** connected at a fold line **12f**, wherein the retaining means is operable to releasably retain the object in a position forward of the front panel when the card is in the folded condition.

Regarding claims 1 and 9, a “bag” is defined as “a container of flexible material, such as paper, plastic, or leather, that is used for storing items.” In this case, the retaining means is a plastic container, which, if sufficient force is applied, is collapsible.

Regarding claims 2 and 3, the retaining means resembles a miniature hand-held shopping basket, which, according to the definition given above, could be called a “bag.”

Regarding claim 4, the object is constrained on all sides, and this constitutes a retention element.

Regarding claim 7, see col. 2, line 63.

Regarding claim 12, an “envelope” is defined as “something that envelops; a wrapping.” The retaining means disclosed by Eisenbraun meets that definition.

Regarding claim 13, the retaining means disclosed by Eisenbraun constitutes a miniature gift box.

4. Claims 18-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Sullivan (WO 93/23254).

See Fig. 1. Sullivan discloses a greeting card comprising a front panel 4 and a rear panel 5 connected at a fold line, the front panel 4 having a front surface and an interior surface such that the interior surface substantially faces the rear panel 5 when the greeting card is in a folded condition; and a collapsible bag structure 6 attached to the front surface such that the collapsible bag structure 6 is positioned forward of the front panel 4, the collapsible bag structure having at least one fold line (see Fig. 1) such that at least a portion of the structure is adjustable to a collapsed condition. It is noted that the designations “front” and “rear” are relative, and changeable, depending upon which way the user is holding the card. The collapsible bag structure is operable to releasably retain a prepaid gift card (or other item) in a position forward of the front panel when the greeting card is in the folded condition. Further, the independent claim is a subcombination claim drawn to a card and a container. Limitations drawn to the object

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to be placed in the container are merely statements of intended use and do not patentably distinguish the claim over the prior art.

Regarding claim 21, the bag structure disclosed by Sullivan is capable of retaining a prepaid gift card.

Regarding claim 22, see retention element 9.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Faiola et al. (4,840,275) in view of Douglas (5,815,964).

Faiola discloses the invention substantially as claimed, as set forth above. However, Faiola discloses a card having only two panels. Douglas teaches that it was known in the art to provide a card having three panels in order to present an interesting puzzle. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the card disclosed by Faiola with three panels, as taught by Douglas, in order to present an interesting puzzle.

7. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Eisenbraun (5,377,836) in view of Douglas (5,815,964).

Eisenbraun discloses the invention substantially as claimed, as set forth above. However, Eisenbraun discloses a card having only two panels. Douglas teaches that it was known in the art

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to provide a card having three panels in order to present an interesting puzzle. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the card disclosed by Eisenbraun with three panels, as taught by Douglas, in order to present an interesting puzzle.

1. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sullivan (WO 93/23254) in view of Douglas (5,815,964).

Sullivan discloses the invention substantially as claimed, as set forth above. However, Sullivan discloses a card having only two panels. Douglas teaches that it was known in the art to provide a card having three panels in order to present an interesting puzzle. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the card disclosed by Sullivan with three panels, as taught by Douglas, in order to present an interesting puzzle.

*Allowable Subject Matter*

8. Claims 26-28 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

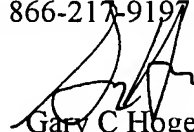
*Conclusion*

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gary C. Hoge whose telephone number is (571) 272-6645. The examiner can normally be reached on 5-4-9.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris can be reached on (571) 272-6651. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Gary C Hoge  
Primary Examiner  
Art Unit 3611

gch